

## REMARKS

Claims 1-9 are pending in this patent application. Reconsideration of this patent application is respectfully requested.

### **First 35 U.S.C. § 103 Rejection**

Claims 1-3 and 5-8 were rejected under 35 U.S.C. § 103 as being unpatentable over Guenter (DE 10019293) in view of Billiet (GB 2,126,497), and Gieseke et al. (US 6,143,049). Reconsideration of claims 1-3 and 5-8 is respectfully requested.

### Discussion Regarding Patentability of Claim 1

#### *Claim 1*

Claim 1 recites the following limitations:

a wall which is made of a coalescing filtration material and which defines a hollow space within it, and an end cap ...

the end cap comprising a peripheral portion which engages the element wall and a tube *which extends into the hollow space defined by the element wall, ...*

the port in the end cap comprises an inner opening defined by the tube and at least one peripheral opening located between the tube and the peripheral portion of the end cap, ...  
(Emphasis Added)

#### *Guenter, Billiet, and Gieseke Cannot Be Combined to Arrive at Applicants' Invention of Claim 1*

The tube 145 of Gieseke (shown in Figs. 5 and 6) does not extend into the hollow space within the wall that is made of the coalescing filtration material as called for in claim 1. Rather, the outlet tube 147 extends within the hollow space of the coalescing filter, while the tube 145 is completely outside of the hollow

space of the filter. No peripheral openings are provided in the cap 175 between the outlet tube 147 and the peripheral portion of the cap 175. (See Fig. 5 of Gieseke) Further, Geiseke's passageways 146 are defined between the inner wall 133 of the housing 80 and the tube 145 *which is located externally* to the coalescing filter element 170. Thus, at best, Gieseke teaches providing openings between a housing wall and a tube positioned *outside* of a coalescing element that defines a hollow space therein.

Thus, even if it would have been obvious to modify the Guenter device to incorporate the teachings of Gieseke so that the Guenter device would include peripheral openings (e.g. passageways 146) defined between an inner wall of a housing (e.g. Gieseke's inner wall 133 or Guenter's inner wall of housing 4) and a tube which is located *externally* to a coalescing element (such as Gieseke's filter element 170 or Guenter's coalescing filter element 5), the resulting combination would not arrive at the invention defined in Applicants' claim 1. Indeed, the resulting combination would not possess an end cap comprising at least one peripheral opening located between a tube which is located *internally* to a coalescing filter element and the peripheral portion of the end cap which is attached a wall of the coalescing element as required by Applicants' claim 1.

Further, Billiet does not disclose at least one peripheral opening defined in an end cap that is located between a tube which is positioned *internally* to a coalescing filter element and a peripheral portion of the end cap which is attached a wall of a coalescing element as required by Applicants' claim 1. Thus,

Billiet cannot make up the above-identified deficiency in the proposed combination.

Since Guenter, Billiet, and Gieseke cannot be combined to arrive at the invention of claim 1, Guenter, Billiet, and Gieseke cannot be combined to establish a prima facie case of obviousness under 35 U.S.C. § 103 with respect to claim 1. Thus, withdrawal of the rejection of claim 1 is respectfully requested.

#### Discussion Re: Patentability of Claims 2-3 and 5-8

Each of claims 2-3 and 5-8 depends directly or indirectly from claim 1. As a result, each of claims 2-3 and 5-8 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 1.

#### **Second 35 U.S.C. § 103 Rejection**

Claim 4 was rejected under 35 U.S.C. § 103 as being unpatentable over Guenter (DE 10019293) in view of Billiet (GB 2,126,497), and further in view of Gieseke et al. (US 6,143,049), and still further in view of Ross (US 2,754,970). Reconsideration of claim 4 is respectfully requested. Claim 4 depends directly from claim 1. As a result, claim 4 is allowable for, at least, the reasons hereinbefore discussed with regard to claim 1.

#### **Third 35 U.S.C. § 103 Rejection**

Claim 9 was rejected under 35 U.S.C. § 103 as being unpatentable over Guenter (DE 10019293) in view of Billiet (GB 2,126,497), and further in view of

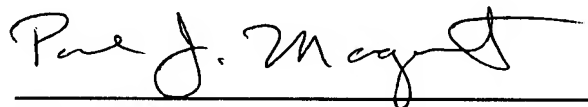
Gieseke et al. (US 6,143,049), and still further in view of Ross (US 2,754,970).  
Reconsideration of claim 9 is respectfully requested. Claim 9 depends directly  
from claim 1. As a result, claim 9 is allowable for, at least, the reasons  
hereinbefore discussed with regard to claim 1.

## **Conclusion**

In view of the foregoing amendments and remarks, it is submitted that this  
application is in condition for allowance. Action to that end is hereby solicited. It  
is respectfully submitted that, if necessary to effect a timely response, this paper  
be considered as a Petition for an Extension of Time sufficient to effect a timely  
response, and any deficiency in fees be charged, or any overpayment in fees be  
credited, to our Deposit Account No. 13-0014.

Respectfully submitted,

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December 3, 2007

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